

\*E-FILED: February 8, 2013\*

NOT FOR CITATION  
IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

TESSERA, INC.,

No. C10-04435 EJD (HRL)

Plaintiff,

**ORDER ON DDJR #1**

v.

**[Dkt. 102]**

UTAC (TAIWAN) CORPORATION,

Defendant.

Plaintiff Tessera, Inc. (“Tessera”) sues Defendant UTAC (Taiwan) Corporation (“UTC”) for alleged failure to pay royalties under a patent license agreement. Tessera alleges breach of contract and breach of implied covenant of good faith and fair dealing, and seeks declaratory relief. The Court bifurcated discovery, and the parties are nearing the end of the first phase, which is limited to issues of contract interpretation.

Tessera’s response to some of UTC’s requests for production included redactions and alterations of responsive documents and withholding of attachments within email families containing one or more responsive documents. A discovery dispute has arisen over whether Tessera is entitled to (1) redact non-privileged portions of responsive documents and (2) withhold non-privileged attachments from email families containing one or more responsive documents. Tessera claims that the redacted and withheld information is non-responsive and confidential business information. None of the redactions, alterations or deletions, however, are based on the attorney-client privilege or work product doctrine. Tessera also claims that providing all of the initially redacted and withheld information would require an extensive re-review of documents, as the redacted and withheld material also contain privileged material and third-party confidential material.

The Court has entered a Stipulated Protective Order for Litigation Involving Patents, Highly Sensitive Confidential Information and/or Trade Secrets (“Protective Order”), whose stated purpose is to shield “confidential, proprietary, or private information” from public disclosure or “from use for any purpose other than prosecuting this litigation.” (Dkt. 72). The Protective Order entered in this case is based on the Court-approved model form provided by this District. It contains provisions for designating material as “Confidential,” or “Highly Confidential – Attorneys’ Eyes Only.” Tessera fails to convince the Court that the Protective Order is insufficient to protect sensitive information that belongs to itself or third parties. Tessera’s claim over the burden of conducting a second review of the documents is also unavailing. Tessera made the decision to alter the original documents and it can bear the repercussions of its choice.<sup>1</sup> Further, Tessera’s claim that it would have to re-review “thousands” of pages of its production does not strike the Court as overly burdensome in the context of this particular litigation.

For these reasons, the Court orders Tessera to re-produce its responsive documents in a form in which they are ordinarily maintained or in a reasonably usable form, without relevance-based redactions or alterations to portions of those documents, and that it produce complete versions of responsive emails with all attachments, no later than **February 14, 2013**. This deadline should not interfere with the depositions scheduled for February 19-21, 2013, as the redacted and previously withheld information is, at least according to Tessera, irrelevant to this matter.

**IT IS SO ORDERED.**

Dated: February 8, 2013

  
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 HOWARD R. LLOYD  
 UNITED STATES MAGISTRATE JUDGE

<sup>1</sup> Tessera’s decision to withhold attachments to emails and make redactions to documents is at odds with Rule 34(b)(2)(E)(i) of the Federal Rules of Civil Procedure, which instructs a party to “produce documents as they are kept in the usual course of business” or “organize and label them to correspond to the categories in the request.”

**C10-04435 EJD (HRL) Order will be electronically mailed to:**

Benjamin W. Hattenbach: bhatenbach@irell.com

Brian David Ledahl: bledahl@irell.com

David H. Herrington: dherrington@cgsh.com

Jennifer Renee Bunn: jbunn@irell.com

Joseph Mark Lipner: jlipner@irell.com, csilver@irell.com, jgejerman@irell.com

Kathleya Chotiros: kchotiros@cgsh.com

Laura Elizabeth Evans: levans@irell.com, ybromley@irell.com

Lawrence B. Friedman: lfriedman@cgsh.com

Michael F. Heafey: MHeafey@orrick.com, jromero@orrick.com, mawilliams@orrick.com

Morgan Chu: mchu@irell.com

Nathaniel E. Jedrey: njedrey@cgsh.com

Richard William Krebs rkrebs@irell.com, rbrown@tessera.com, Slee@irell.com,  
sveeraraghavan@tessera.com, tegarcia@tessera.com

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